

REMARKS

Claims 5, 7, and 22-36 have been canceled. Claims 22-36 are drawn to non-elected subject matter. Therefore, Applicants reserve the right to pursue such claimed subject matter in a Divisional/Continuation application. Claims 1 and 20 are amended to include the embodiment of Claim 7 in order to obtain an allowance in the present case. Applicants do not necessarily agree with the grounds of rejections of the original scope of the originally filed claims; and therefore, reserve the right to pursue the original claimed subject matter in a Divisional/Continuation application. Support for the amendment is found in original Claims 5 and 7. No new matter is believed to be obviated by the above amendment.

Claims 1-4, 6, and 8-21 are pending. Favorable consideration is respectfully requested.

At the outset, Applicants thank Examiner Goodrow for the courteous discussions of the present application during the time period from the issuance of the outstanding Office Action and the filing of the amendment herein. Further, Applicants thank Examiner Goodrow for indicating that the outstanding rejections would be withdrawn if Claims 1 and 20 were amended to include the embodiments of Claim 7. As a reminder, Claim 7 specifies the softening points and glass transition temperatures of polymers A, B and C. Applicants thank Examiner Goodrow for his kind suggestions and thank him for indicating that the above-mentioned amendment appears to place the present application in condition for allowance.

The rejection of Claims 1-21 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki et al. in view of Aoki et al. and Tavernier et al. is believed to be obviated by the above-mentioned amendment.

Suzuki et al. discloses, at best, an electrographic toner having a binder colorant and release agent. However, Suzuki et al. fails to disclose or suggest the claimed toner

composition containing a binder resin and a release agent where the binder resin further contains a non-linear polymer A, a linear polymer B, and a polymer C in which the following relationships thereof are satisfied

$$T_m(A) > T(C) > T_m(B)$$

$$|T_g(A) - T_g(B)| < 10 (^{\circ}\text{C})$$

$$30 \leq T_m(A) - T_m(B) \leq 60 (^{\circ}\text{C})$$

where $T_m(A)$, $T_m(B)$ and $T_m(C)$ represent softening points of the non-linear polymer A, the linear polymer B and the polymer C, respectively; and $T_g(A)$ and $T_g(B)$ represent glass transition temperatures of the non-linear polymer A and the linear polymer B, respectively.

Aoki et al. disclose, at best, a non-linear polyester and a release agent utilized with a wax. However, Aoki et al. fails to disclose or suggest a toner composition containing a binder resin and a release agent where the binder resin contains a non-linear polymer A, a linear polymer B, and a polymer C which satisfies the following relationships

$$T_m(A) > T(C) > T_m(B)$$

$$|T_g(A) - T_g(B)| < 10 (^{\circ}\text{C})$$

$$30 \leq T_m(A) - T_m(B) \leq 60 (^{\circ}\text{C})$$

where $T_m(A)$, $T_m(B)$ and $T_m(C)$ represent softening points of the non-linear polymer A, the linear polymer B and the polymer C, respectively; and $T_g(A)$ and $T_g(B)$ represent glass transition temperatures of the non-linear polymer A and the linear polymer B, respectively.

Tavernier et al. disclose, at best, a mixture of polymers in a toner with a release agent such as wax. However, Tavernier et al. fail to disclose or suggest a toner composition containing a binder resin in a release agent where the binder contains a non-linear polymer A, a linear polymer B, and a polymer C and satisfies the following relationships

$$T_m(A) > T(C) > T_m(B)$$

$$|T_g(A) - T_g(B)| < 10 (^{\circ}\text{C})$$

$$30 \leq T_m(A) - T_m(B) \leq 60 (^{\circ}\text{C})$$

where $T_m(A)$, $T_m(B)$ and $T_m(C)$ represent softening points of the non-linear polymer A, the linear polymer B and the polymer C, respectively; and $T_g(A)$ and $T_g(B)$ represent glass transition temperatures of the non-linear polymer A and the linear polymer B, respectively.

In direct contrast, the claimed invention relates to a toner composition containing toner particles having a binder resin and a release agent where the binder resin contains a non-linear polymer A, a linear polymer B, and a polymer C and satisfies the following relationships

In light of the above and with respect to one of the above-mentioned discussions with Examiner Goodrow on May 28, 2003, it is clear that Suzuki et al. fail to disclose the claimed invention. Further, both Aoki et al. and/or Tavernier et al. fail to provide what Suzuki et al. omits. Accordingly, no combination of Suzuki et al. with Aoki et al. and/or Tavernier et al. disclose or suggest the claimed invention.

In light of the above, it appears as if the Office is relying on the Applicants disclosure to supply motivation to modify the compositions disclosed by Suzuki et al., Aoki et al. and/or Tavernier et al. to contain a non-linear polymer A, a linear polymer B, and a polymer C and satisfies the following relationships

$$T_m(A) > T_m(C) > T_m(B)$$

$$|T_g(A) - T_g(B)| < 10 (^{\circ}\text{C})$$

$$30 \leq T_m(A) - T_m(B) \leq 60 (^{\circ}\text{C})$$

where $T_m(A)$, $T_m(B)$ and $T_m(C)$ represent softening points of the non-linear polymer A, the linear polymer B and the polymer C, respectively; and $T_g(A)$ and $T_g(B)$ represent glass transition temperatures of the non-linear polymer A and the linear polymer B, respectively.

However, this is clearly improper according to a recent decision by the U.S. Federal Courts in *In re Lee* (61 USPQ2d 1430). The *Lee Court* indicated that the Office must provide specific

motivation, hint, or suggestion, found in the references relied upon to support a prima facie case of obviousness. In the present case, the Office appears to rely on the present specification for motivation, which is clearly forbidden according to the Lee Court. In light of this decision, Applicants respectfully request the Office not to use the present specification to find motivation that is not present in any of the disparate disclosures of the references discussed herein. Accordingly, withdrawal of this ground of rejection is respectfully requested.

In the outstanding Office Action, the Examiner requested Applicants to indicate which references disclose to the United States Patent and Trademark Office are "material" to the patentability of the instant claims. Applicants respectfully submit that all references disclose to the patent office thus far appear to be "material" to the patentability of the instant claims. Further, Applicants submit an additional list of related cases herewith which provides the United States Patent and Trademark Office with additional applications which appear to be "material" to patentability to the claimed invention.

Applicants respectfully submit that the present application is now in condition for allowance. Early notice to this effect is respectfully requested. Should anything further be required to place this application in condition for allowance, the Examiner is requested to contact the undersigned by telephone.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)

Norman F. Oblon
Attorney of Record
Registration No. 24,618

Thomas W. Barnes III, Ph.D.
Registration No. 52,595